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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/287,248	04/07/1999	JOHN T. MCDEVITT	5119-00501	6075

7590 08/18/2003  
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EXAMINER

PADMANABHAN, KARTIC

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/287,248

Applicant(s)

MCDEVITT ET AL.

Examiner

Kartic Padmanabhan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36,39,173 and 174 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36,39,173 and 174 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 26.                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/13/03 has been entered.

### ***Claim Objections***

2. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The independent claim, claim 1, already recites a plurality of particles within a plurality of cavities, such that the limitation of a plurality of particles within a cavity in claim 3 is not deemed to further limit the parent claim.

3. Claim 18 is objected to because of the following informalities: applicant should insert an "s" after "micron" in line 1 of the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 173 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claim 173 recites the limitation "the flood light source" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-36, 39, and 173-174 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,602,702 and claims 1-45 of U.S. Patent No. 6,589,779. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in both patents, just like the present invention, recite a system comprising a light source and sensor array, the sensor

array comprising a supporting member with multiple cavities and a top cover layer which is coupled to the top of the supporting member such that a particle is contained within the cavity. The system also comprises particles and a detector, wherein the detector detects the signal produce by interaction of the analyte with the particle. According to all sets of claims, light passes from the light source to the particle, and then onto the detector.

9. Claims 1-36, 39, and 173-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-160 and 309-335 of copending Application No. 09/775,048. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite a system comprising a light source and sensor array, the sensor array comprising a supporting member with multiple cavities. The system also comprises particles within the cavities and a detector, wherein the detector detects the signal produce by interaction of the analyte with the particle. According to both sets of claims, light passes from the light source to the particle, and then onto the detector.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-36, 39, and 173-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-160 and 343-396 of copending Application No. 09/775,340. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite a system comprising a light source and sensor array, the sensor array comprising a supporting member with multiple cavities. The system also comprises particles within the cavities and a detector,

wherein the detector detects the signal produce by interaction of the analyte with the particle.

According to both sets of claims, light passes from the light source to the particle, and then onto the detector.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-36, 39, and 173-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-160 and 327-377 of copending Application No. 09/775,342. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite a system comprising a light source and sensor array, the sensor array comprising a supporting member with multiple cavities. The system also comprises particles within the cavities and a detector, wherein the detector detects the signal produce by interaction of the analyte with the particle. According to both sets of claims, light passes from the light source to the particle, and then onto the detector.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1-36, 39, and 173-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-160, 342-374, and 399-444 of copending Application No. 10/072,800. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite a system comprising a light source and sensor array, the sensor array comprising a supporting member with multiple cavities. The system also comprises particles within the cavities and a

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detector, wherein the detector detects the signal produce by interaction of the analyte with the particle. According to both sets of claims, light passes from the light source to the particle, and then onto the detector.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Conclusion**

Claims 1-36, 39, and 173-174 are rejected.

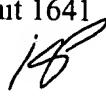
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kartic Padmanabhan whose telephone number is 703-305-0509. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Kartic Padmanabhan  
Patent Examiner  
Art Unit 1641

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CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800-1641

5/16/03